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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA VA 22314

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JUL 08 2010

In re Application of: :
Jun Yonemitsu et al. :
Application No. 09/522,786 : **OFFICE OF PETITIONS**
Filed: March 7, 2000 : **PETITION DECISION**
Attorney Docket No.: 275913US6RE :

This is a decision on the DECLARATION OF KOICHI WADA, filed January 28, 2010, which is being treated as a petition under 37 CFR 1.183 to waive the requirements of 37 CFR 1.64.

The petition is **dismissed**.

An originally named inventor, Ryuicyhi Iwamura, who signed the originally filed declaration, is allegedly refusing to sign a supplemental reissue declaration. Petitions under 37 CFR 1.47(a) apply to situations where a joint inventor refuses to join in an application or cannot be found or reached. However, petitions under 37 CFR 1.47(a) are only applicable to the initial execution of an original oath or declaration and are not applicable to supplemental oaths or declarations by the originally signing inventor. In such circumstances, the USPTO will consider a petition under 37 CFR 1.183 requesting waiver or the requirements of 37 CFR 1.64 that each of the actual inventors execute the supplemental oath or declaration.

MPEP 603 states in part:

When an inventor who executed the original declaration is refusing or cannot be found to execute a required supplemental declaration, the requirement for that inventor to sign the supplemental declaration may be suspended or waived in accordance with 37 CFR 1.183. All available joint inventor(s) must sign the supplemental declaration on behalf of themselves, if appropriate, and on behalf of the nonsigning inventor. See MPEP § 409.03(a).

In discussing waiver requirements under 37 CFR 1.183, the Office is guided by proof similar to that required when an applicant is unavailable or refuses to sign. Petitioner indicates that the non-signing inventor Iwamura cannot be located to sign the replacement declaration.

MPEP 409.03(d) (II) states in part:

Where a refusal of the inventor to sign the application papers is alleged, the

circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient.

The applicable statute (35 U.S.C. § 116) requires that a "diligent effort" have been expended in attempting to find or reach the non-signing inventor. The showing currently fails to demonstrate, with a documented showing, that a diligent effort was made to find or locate non-signing inventor Iwamura. Where inability to find or locate a named inventor(s) is alleged, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made to locate the inventor.

Petitioner has not demonstrated that all efforts were expended in trying to locate inventor non-signing Iwamura. In this regard, petitioner should, at the very least, conduct a search of the regional or national registry(s). The results of such search should be made in any future petition for reconsideration. Additionally, petitioner should state whether he has access to inventor Iwamura's personnel records and, if so, what does inspection of the records reveal as to a current address, forwarding address, or an address of the nearest living relative? What does inspection of the phone directories for those address locations reveal? If a forwarding address is provided, petitioner should then mail a complete copy of the application papers (specification, claims, drawings, oath, etc.) to Iwamura's address, return receipt requested, along with a cover letter of instructions which includes a deadline or a statement that no response will constitute a refusal. This sort of ultimatum lends support to a finding of refusal by conduct. If the papers are returned and all other attempts to locate or reach the inventor, e.g., through personnel records, co-workers, E-mail, the Internet or the telephone, etc., continue to fail, then applicant will have established that the inventor cannot be reached after diligent effort or has refused to join in the application. The statements of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein and should be accompanied by documentary evidence in support of the statement of facts. It is important that the forthcoming communication contain statements of fact as opposed to conclusions.

The statement of facts by Koichi Wada does not meet the above discussed requirements. Further, there is no indication of any attempt to mail the supplemental declaration and a copy of the application to Iwamura, instead, it appears that there were only several attempts to contact Iwamura.

For the reasons presented above, the petition is dismissed.

The fee for a petition filed under 37 CFR 1.183 has been charged to petitioner's deposit account.


Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Director for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (571)273-8300
 Attn: Office of Petitions

By hand: Customer Service Window
 Mail Stop Petition
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Telephone inquiries concerning this matter should be directed to Carl Friedman at (571) 272-6842.


David Bucci
Petitions Examiner
Office of Petitions